

REMARKS

Reconsideration of the above-identified application in view of the amendment above and the remarks below is respectfully requested.

Claims 1, 11, and 49-55 have been canceled in this paper. Claims 2-10, 34-35, and 41-43 have been amended in this paper. No new claims have been added in this paper. Therefore, claims 2-10 and 34-48 are pending and are under active consideration.

Claims 49-55 stand rejected under 35 U.S.C. 112, first paragraph, "as failing to comply with the enablement requirement."

Without acquiescing in the propriety of the rejection, Applicant has canceled claims 49-55 in this paper. Therefore, the rejection is moot and should be withdrawn.

Claims 1, 11, 34-36 and 41 stand rejected under 35 U.S.C. 102(b) "as being anticipated by Dewar et al. (Neuro-Psychopharmacology & Biological Psychiatry 1985, 9(5-6), 675-680)," and claims 34-48 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Dewar et al. (Neuro-Psychopharmacology & Biological Psychiatry 1985, 9(5-6), 675-680)." In support of the rejection, the Patent Office repeats its reasons of record and, later in the Office Action, states the following:

Applicant has traversed the above art rejections. Applicant has argued that the amended claims are limited to "Substantially isolated Deuterated catecholamine derivative..." and that the Dewar reference fails to teach or suggest the compound of formula I, the L-enantiomer, in a substantially isolated state. The above argument is not found persuasive because the L-isomer is not a limitation of the instant claims. Applicant is arguing limitations not present in the claims. Applicant agrees that Dewar teaches D3-DL-dopa racemates. Since the claims are not directed to a single isolated isomer, Dewar meets the limitations of the instant claims as described in the rejection of record.

Insofar as the subject rejections relate to claims 1 and 11, the rejections are moot in view of Applicant's cancellation of claims 1 and 11 in this paper. Insofar as the subject rejections relate to claims 34-48, Applicant respectfully traverses the subject rejections.

As best understood by Applicant, the Patent Office appears to be taking the position that, although Dewar et al. is limited to teaching D3-DL-dopa racemates, the claims, as previously presented, were not directed at a single isolated isomer and, thus, read on the Dewar racemates. Without acquiescing in the propriety of the Patent Office's position, Applicant has amended claim 34 (from which claims 35-40 depend), claim 41, and claim 42 (from which claims 43-48 depend) so that all of the rejected claims are directed at a substantially enantiomerically pure compound. As a result, the claims are clearly distinguishable over the racemate of Dewar et al. The surprisingly improved properties of the claimed substantially pure enantiomer are discussed in prior papers submitted to the Patent Office.

Accordingly, for at least the above reasons, the subject rejections should be withdrawn.

Claims 2-10 stand objected to "as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims."

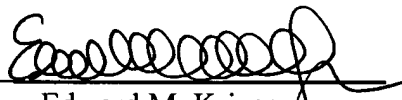
In response to the above, Applicant has rewritten each of claims 2-10 in independent form, except that Applicant has not recited the "substantially isolated deuterated" language of claim 1 for the reason that the Patent Office's indication of allowability does not appear to be predicated on the presence of such language. (Applicant notes that the same objection and indication of allowability were made in a prior Office Action in which the language in question was not recited.)

In conclusion, it is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

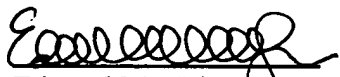
Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 18, 2009.


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